

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re App. No.:	09/449,021)	<u>PATENT APPLICATION</u>
)	
Filing Date:	November 24, 1999)	Art Unit: 2192
)	
Inventors:	Helmut Emmelmann)	Examiner: Kendall, Chuck
)	
Title:	<i>Interactive Server Side</i>)	
	<i>Components</i>)	

Customer No.: 28554

PETITION FOR REINCLUSION OF CLAIMS INTO APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On July 12, 2011, the USPTO issued a Second Examiner's Answer with a new ground of rejection, replacing the previous examiners answer from October 2010. The examiner also entered amendments that had been proposed by appellant when filing its first Reply Brief to cancel various claims the examiner had allowed in the first answer, and applicant filed those claims as continuation application 12/966,976.

In an interview in early 2011, appellant asked the Examiner to not to cancel the claims, since the examiner was thinking about rejecting the claims in the child application. An office action was mailed in the child case on September 7, 2011, rejecting most of the previously allowed claims on the same new ground of rejection.

Appellant finds the action of the Examiner to be unjust and unfair, and herewith asks the Commissioner to reverse the Examiner's decision to cancel the previously allowed and cancelled claims, including claims 6,8,24,25, 51-58, 74-89, 114-128 that were rejected in the continuation

case, and claims 3-5, 27-29, 31, 43, 64-66, and 70, which were allowed in the continuation, but with significant limitations after negotiations with the examiner by way of numerous interviews.

Appellant also asks that this appeal be heard as quickly as possible given the long pendency of this application.

Together with this petition applicant files a second reply brief upholding the appeal and discussing the newly cited art and why applicant thinks the examiner misinterprets this art.

REASONS:

Appellant requested cancellation of certain claims during appeal based on the representation in the original Answer that those claim were allowable. However, the PTO has once again reversed itself (a previous Notice of Allowance was withdrawn in 2008) and replaced the original Answer with a new one having new grounds of rejection, and likewise rejected allowable claims on the same basis in the continuation. Therefore, appellant's request to cancel claims based was based on a false and/or erroneous decision of the PTO, and thus appellant should be given the opportunity to reverse course as well.

Certainly applicant could move the continuation application to appeal as well, but this would mean additional delay in the case. Given the long and tortured prosecution history here, such delay could lead to a very short patent term or no patent term at all.

Applicant fears that considerable additional delay in the continuation application will occur because it has occurred in this parent case, and the continuation application has a recent filing date despite the status of the parent as "special."

The new ground of rejection recited in the office action of the continuation case as well as in the second examiners answer is based primarily on the same "WebWriter" prior art combined with a newly cited patent to Faustini, and applicant thinks that the examiner is still misinterpreting the WebWriter prior art as well as the newly cited art, and that the newly cited art does not contribute the missing elements. Therefore, the appeal brief is still very relevant for the new rejection. And two appeals with more or less the same topic puts an unjustified burden in fees and additional work on applicant and extra work on the PTO as well.

Applicant filed the first notice of appeal in September 2005 and has been frustrated by the slow progress in this case since then. In April 2008, applicant received an allowance after agreeing to additional limitations asked by the examiner, but the application was withdrawn from issue in July 2008. Applicant sought to continue the appeal, but the case was returned to

prosecution, further amendments were made, and a new notice of appeal was filed in January 2010.

Since the first notice of appeal in September 2005, the claims were rejected three times on new grounds and allowed two times, whereby the allowance was twice withdrawn later by the PTO. Applicant feels deprived on his right to appeal by delay and also by delays caused by actions from the PTO that later on are withdrawn or just replaced. Certainly applicant still has the right to appeal, but an appeal decision cannot possibly reverse the patent term lost by the delays.

Applicants points out that the extraordinary long time of prosecution of this application has been caused by a lot of rejections on new or changed grounds, which apparently all have been overcome except for the last one. Also, in 2008 the case was withdrawn from issue based on a "quality review" reciting an article that application had submitted as the first item of the first IDS submitted in 2000, the PTO should have considered and applied this item of prior art long before. On the other hand, the rejection based on that item was now reversed which indicates that the decision of the quality review was wrong as well. In addition, office actions do not appear to have been accelerated despite the fact that the application is considered "special."

Respectfully submitted,

Date: September 12, 2011

By: /Richard A. Nebb/
Richard A. Nebb
Reg. No. 33,540

DERGOSITS & NOAH LLP
3 Embarcadero Center, Suite 410
San Francisco, California 94111
Telephone: 415.705.6377
Facsimile: 415.705.6383